

Serial No. 10/784,898PATENT/OFFICIALREMARKS

In the Office Action, the Examiner noted that claims 21-38 are pending in the application, and that claims 21-38 are rejected. By this Amendment, no claims have been amended or added. Thus, claims 21-38 are pending in the application.

Applicants respectfully traverse the rejections by the Examiner.

Rejection Under 35 U.S.C. § 103(a)

Claims 21-38 are rejected as being obvious in view of the following prior art references: U.S. Patent 5,764,923 to Tallman, in view of Donnelly ("Counseling Nurses are Health Care Innovators"), in view of U.S. Patent 5,758,095 to Albaum, and further in view of Moench ("Demand Management: The New Business in Patient Communications"). Applicant respectfully disagrees.

U.S. Patent 5,764,923 to Tallman "Medical network management system and process" relates to a patient medical problem diagnosing method for automated medical advice system. In a medical network management system (NMS), health plan beneficiaries access a team of health care professionals over the telephone to help them assess their health needs and select appropriate care. The NMS has a patient assessment component that consists of a set of information tools which are used by health care professionals to assess patient conditions and

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assist in the selection of health care services. The tools include an automated set of proprietary assessment algorithms, which are based on branched chain algorithms utilizing Bayes theorem. These clinical tools enable a trained nurse or other health care professional to sort patients into different risk categories, safely and effectively without requiring a medical diagnosis. Patients can then be guided to an appropriate level and type of care for their problem(s) based on their level of risk and set of potential needs. The principle of operation in Tallman is to reduce the number of potential patients from visiting physicians. Tallman does not teach or suggest, among other recited features, the feature of taking into account a patient's prescription drug history.

U.S. Patent 5,758,095 to Albaum "Interactive medication ordering system" relates to a system and method for ordering and prescribing drugs for a patient. This system includes an improved process for facilitating and automating the process of drug order entry. The system includes a database containing medical prescribing and drug information which is both general and patient-specific. The system also permits the user to view current and previously prescribed medications for any patient. The system can alert the user to potentially adverse situations as a result of the prescribed medication based on information in the database. The system also can automatically determine product selection based on descriptions and can automatically communicate the order to a pharmacy. Further, the system includes a means for automatically displaying messages to the user relating to predetermined situations. For example, such situations may include a medication, which is not available in the formulary or the prescription of a non-recommended medication.

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Donnelly "Counseling Nurses are Health Care Innovation" is a telephone-based nurse counseling provided by an insurance company, managed health care organization or employer.

Moench "Demand Management: The New Business in Patient Communications" relates to providing new roles for nurses and other health care professionals as "learned intermediaries" for additional education. This article indicates that demand management companies are used to keep patients out of hospitals. This article discusses the "Mary C." example, where Mary calls a toll free number regarding involuntary urination. Mary discusses her problem, and is generally asked whether she is taking medications, and that some medications can make bladder control difficult. Mary is then told that she should feel free to discuss this issue with her physician. Moench admits that Demand Management is separate from the pharmaceutical industry for which such techniques have not yet been developed: "There may be some important synergies between pharmaceutical companies and demand management firms, as the pharmaceutical industry moves to develop critical pathways and/or disease mapping case management (the next phase of management)."

In contrast, the claimed invention of the present application is a method (and a system) that provides, in at least one embodiment of the invention, among other features, a comprehensive and in-depth set of information to an operator, prior to diagnosis by a physician, in providing medical services to a caller regarding at least one pharmaceutical that the caller is currently using. The combination of features of, for example, claim 21 allows the operator to provide, efficiently and economically, integrated decision support to gather, maintain and update

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medical, pharmaceutical, demographic, psycho-graphic, and health benefit information of members and to maintain and provide medical, pharmaceutical, and customer service information and advice to the caller.

Applicant respectfully submits that none of the cited references, either alone or in combination, teaches or suggests the combination of features as required in claim 21. Without conceding that the prior art cited by the Examiner discloses any of the features of the present invention, Applicant provides the following reasons why the presently claimed invention as recited in Claim 21, patentably distinguishes over the prior art.

**The combination of cited references does not teach or suggest activities for a new action**

As recited above, claim 21 explicitly requires the feature of "(j) targeting for new action, by the computer system, the members associated with the health plan using the member profile information including the health benefit plan information, the prescription drug history, the self-reported health information, and the recent contact history when at least one of the clinical information, the pharmaceutical information and the health benefit information are updated."

The Examiner stated that this feature is shown in FIG. 39 and Col. 31, ll. 42-57 of Tallman. However, the cited portions of Tallman are directed only to a call back operation (akin to a call back action recited in (i) of claim 21). In other words, Tallman does not teach or suggest the feature of "targeting for new action" when "at least one of the clinical information, the pharmaceutical information and the health benefit information are updated," which is

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different from a call back action. No such feature is taught or suggested in Moench and Donnelly. Hence, even if the cited references are combined as the Examiner suggested, the combination does not teach or suggest the above recited feature.

**The combination of Tallman and Donnelly does not teach or suggest using member profile information**

Claim 21 requires, among other features, "(b) providing, by the computer system, the one or more operators with member profile information associated with the caller including health benefit plan information, prescription drug history, self-reported health information, and recent contact history, including, when present, a list of allergies, prescriptions, and pre-existing health conditions associated with the caller." In particular, the member profile information includes a list of allergies, prescriptions and pre-existing health conditions associated with the caller. As the Examiner noted, such information is "crucial when assessing a patient's present condition and prescribing additional medications." (P. 7, Office Action).

In the Office Action, the Examiner conceded that Tallman "does not explicitly teach the incorporation of prescription or allergy information with a caller's health history" (P. 7, Office Action). In other words, the member profile information is required in claim 21 to include a list of allergies, prescriptions and pre-existing health conditions, and no such feature is taught or suggested by Tallman. However, the Examiner asserted that Donnelly teaches the missing feature. The Examiner further took an Official Notice that "it is old and well-known in the art of

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maintaining a prescription drug history to also include the history information regarding any drug allergies." The Examiner then cited Moench as providing further support "of the usefulness of knowing a caller's drug history, including drugs currently being used" (P. 8, Office Action).

First, with respect to Moench, it does not teach the feature relating to a caller's drug history or drugs currently being used. The Examiner cited an example of a conversation between a caller and a nurse ¶¶ 17-20. However, in the cited example, the caller is asked whether the caller is taking any medicine (not a specific medicine). When the caller answered affirmative, the nurse commented that "some prescription medicines" might cause side effects. The example in Moench does not teach or suggest that the nurse has information relating to specific medicines that the caller is currently using (as required by claim 21). It suggests that the nurse knows only whether the caller is taking any prescription drug.

Second, with respect to the Official Notice, Applicants respectfully traverse the Notice and request that the Examiner provide supporting references and/or an affidavit. Applicant reminds the Examiner that the present application claims priority to September 29, 1998.

Third, with respect to Donnelly, it may state that its computer may have access to "a caller's history of" prescriptions, but it does not teach or suggest how that information is to be used in the ways required by claim 21 of the present invention. In particular, it does not teach or suggest "(e) automatically linking, prior to the diagnosis by the physician, by the computer system, the member profile information" and "(i) targeting for follow up action, by the computer system, members of the health plan using the member profile information," among

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other features, because it fails to teach or suggest the member profile information as required in claim 21. Put differently, the step of "automatic linking" of the member profile information cannot take place without having the member profile information (same with the step of targeting for follow-up action using the member profile information). As noted above, the Examiner conceded that Tallman does not describe the member profile information that includes prescription or allergy information. Hence, even if Tallman and Donnelly are combined as suggested by the Examiner the above-cited features of claim 21 are not taught or suggested in the combination.

The combination of Tallman and Moench does not teach or suggest automatically sending information to a physician

Claim 21 requires, among other features, "(g) generating, by the computer system, at least one of reports with respect to the health related issue and notices including information collected during the communication with the caller, combined with specific pharmacy information, for delivery to the physician of the caller, and the caller's health plan with respect to the health related issue."

The Examiner again conceded that Tallman "fails to explicitly disclose that the caller's physician and the caller's health plan are provided with all details of the call." (P. 8, Office Action.) However, the Examiner then asserted that the Moench disclosed the missing feature by citing a portion thereof. Applicants respectfully submit that the cited portion only discusses a nurse counselor sending an e-mail message to a patient's physician to advise him/her of the

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encounter and advice provided. (¶ 34, Moench). In contrast, the above-cited portion of claim 21 specifically requires that a computer automatically generate the reports or notices to be sent to the physician or the health plan. **There is no teaching or suggesting in Moench that the reports or notices are to be generated automatically, among other features.**

The Examiner attempted to provide motivations by stating that "for delivery to the physician of the caller with respect to the health related issue in order to allow the caller's physician to safely and efficiently follow up on his/her patient's condition" and that "in order to provide the health plan with feedback regarding the success of the call center program and with means to track the health related issues of its members for the future demand management programs" (P. 9, Office Action). However, **these motivations do not provide any reason to modify Tallman to automatically generate the reports or notices. Hence, even if Tallman and Donnelly are combined as suggested by the Examiner the above-cited features of claim 21 are not taught or suggested in the combination.**

#### Additional Differentiators

Applicant also asserts that the prior art, either alone or combined, **fails to teach or suggest, among other features, linking, by the computer system, "the at least one health issue with the information relating to one or more drugs that have been prescribed to the caller."** In addition, the prior art, either alone or combined, fails to teach or suggest, among other features, "**(c) determining, by the computer system, whether medical history associated with the at least one caller includes the at least one drug prescribed to the at least one caller.**"

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The Examiner took at least four additional Official Notices between pages 8-10 of Office Action relating to the following features: 1. "auditing and monitoring procedures" (page 8); 2. "a health care plan to target its members with educational, medical materials" (page 9); 3. "prescriptions called in by a physician's representative on a patient's behalf" (page 10); and 4. "prescribe medication covered by a patient's health care plan" (page 10). Applicants respectfully traverse the Notices and request that the Examiner provide supporting references and/or an affidavit under 37 C.F.R. Section 1.104(d)(2). In the absence of either, Applicant requests withdrawal of this rejection.

Further, the following is a list of additional missing features in the cited references. The following list is exemplary, and should not be construed as meaning that additional differences between the claimed invention and the prior art do not exist. In fact, other differences will also be apparent to one of ordinary skill. For example, the following features are asserted to be missing from Iliff: determining a new action using the member profile information including the health benefit plan information, the prescription drug history, the self-reported health information, and the recent contact history when at least one of the clinical information, the pharmaceutical information and the health benefit information are updated; providing one or more operators with member profile information associated with the caller including health benefit plan information, prescription drug history, self-reported health information, and recent contact history, including,

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when present, a list of allergies, prescriptions, and pre-existing health conditions associated with the caller; and/or generating reports with respect to the health related issue and notices including information collected during the communication with the caller, combined with specific pharmacy information, for delivery to the physician of the caller, and the caller's health plan with respect to the health related issue.

In addition, dependent claims 22-35, which depend, directly or indirectly, from independent claim 21, and incorporate the limitations of claim 21, as well as independent claims 36-38, also include additional limitations that are not shown or suggested by the prior art. Applicants respectfully submit that dependent and independent claims 22-38 patentably distinguish over the prior art. Withdrawal of this rejection for these reasons as well is respectfully requested.

Applicants believe all pending claims are in the form to be allowed. An early notice is earnestly solicited.

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Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

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Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

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For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

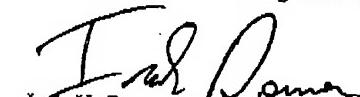
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The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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